



6484/XP-1128/tat

"PATENT APPLICATION"

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

In re Application of

WILLIAM N. DAVIS ET AL

U.S. Serial No. 10/621,275

Group Art Unit 2178

Filed: July 17, 2003

D. Faber, Examiner

FONT RENTAL SYSTEM AND METHOD

Alexandria, Virginia
January 28, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF

Dear Sir:

This Reply Brief is being submitted in response to the Examiner's Answer mailed November 27, 2007 in order to respond to new points of argument raised by the Examiner and to avoid acquiescence in the position of the Examiner. If a point raised by the Examiner is not specifically addressed herein, such is not to be understood as acquiescence therein, but rather that applicants rely on the Appeal Brief earlier filed September 17, 2007.

Initially, it is noted that a typographical error is present in the Examiner's Answer at page 2 in section (8)

listing the patents relied upon. U.S. Patent No. 6,882,334 should read 6,882,344.

The Grounds of Rejection as set forth in section (9) at pages 3-13 set forth the rejections as present in the final official action mailed June 28, 2006. Accordingly, appellants rely on their principle brief as to these arguments.

As to section (10), "Response to Argument", at page 14, second full paragraph, the Examiner asserts that appellants rely on features not recited in the claims and sets forth the example of "to provide or implement or enforce a license or sale including limitations". Appellants submit that the features relied upon in their principle brief are claimed. For instance, in response to the example asserted by the Examiner, it is noted that independent claim 18 includes the limitation that the font provider sends the font consumer a license enabling the consumer to use the font for a specified period of time and a specified use access where, upon expiration of the specified time period, the font is disabled. As to "sale", appellants do not rely on a "sale" as a claim feature. Appellants claims are directed to methods or system involving a transaction which is a "font rental", not a

"sale". The claims involve methods and systems including, among other things, for exchanging defined information and obtaining predetermined use access for a predetermined period of time. The language "sale including limitations" relied on by the Examiner is from appellants describing the failings in teaching of the applied art.

At page 14, last paragraph, the Examiner asserts that he is unsure which features and limitations appellants are focusing on and asserts that appellants are arguing the claims as a whole as to Ying. Based thereon the Examiner reasserts at page 15, line 1 to page 17, line 3, essentially the same asserted description of Ying as set forth at page 3, line 8 to page 5, line 2, of the Examiner's Answer.

Contrary to the Examiner's assertion, appellants submit that specific features claimed by appellants and not taught by Ying or Hayes is specifically set forth in their principle brief, for example, at page 8, first full paragraph, and as further expanded on in the description of the applied art following thereafter. Accordingly, appellants submit that their principle brief addresses the Examiner's assertions as set forth at page 15, line 1 to page 17, line 3.

At page 17, the Examiner asserts that he is "modifying Ying's invention of distributing fonts to include the features disclosed in Hayes, not the entire invention, based on what is stated in the language of the claim language. ... Hayes also discloses the feature to distribute and manage fonts by having fonts be used by users for a short time, then disabled when time expires. Thus, Ying and Hayes disclose a common endeavor in the same field of art since Ying and Hayes discloses distributing and managing fonts. In conjunction with Ying, Ying and Hayes provide a license that defines the length of time usable and access rights, wherein the length of time expires, the font would be disabled until further action is decided by the user which provides a font management system aiding in buying, selling, and distribution of fonts and for implementing limited access to fonts after terms of agreement have expired." (emphasis added)

Appellants submit that the Examiner is not considering the teachings of the references as described or as whole, but is only selecting isolated portions which even on combination do not provide appellants claimed invention

since the Examiner has not provided for a critical feature of appellants' methods and systems as claimed, i.e., that such is for distributing fonts or management of fonts, respectively, by rental. Appellants respectfully submit that the Examiner has characterized isolated portions of the applied art teachings only to an extent which supports the Examiner's assertions in absence of the specific teachings of the reference as a whole. Ying teaches solely the sale of fonts. As acknowledged by the Examiner, Ying does not disclose tracking of a font provided to a consumer so that upon expiration of a predetermined time period such is disabled. Hayes also does not teach or suggest "rental" of a font. Hayes teaches a limited sampling or preview of a font as an enticement to purchase of a font outright. This sampling is in the absence of an terms or agreement for purchase for either limited use or sale. Hayes does not teach or suggest a predetermined use access based on provision of defined information for a predetermined period of time. Following the "sampling" (limited disclosure) of Hayes, only a full purchase sale of one or more fonts is provided as an option. No other arrangement, such as a limited access license, is taught or suggested. The "sampling" of Hayes is simply a limited taste or teaser to entice a consumer to purchase the font outright by sale. Such is not the same as a rental wherein the consumer

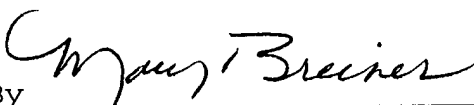
6484/USSN 10/621,275
Group Art Unit 2178

chooses the time period and degree of use access of a selected font and, accordingly, has an unfettered ability to complete a desired activity requiring use of the rented font. The advantage of appellants' invention is to avoid the need to purchase outright a font, thereby avoiding the cost and storage needs of such purchase, and yet having a sufficient use of the font for the consumer to complete a desired task. "Samplings" or "previews" by their nature do not allow complete enjoyment of an item, otherwise no purchase of the item will be forthcoming which is the object of the seller. Thus, a combination of Ying and Hayes falls short of providing appellants' claimed methods and systems.

Appellants submit that the appealed claims are patentable within the meaning of 35 U.S.C. §103 and requests reversal of the Examiner's rejections.

Respectfully submitted,

WILLIAM N. DAVIS ET AL

By 
Mary J. Breiner, Attorney
Registration No. 33,161
BREINER & BREINER, L.L.C.
P.O. Box 320160
Alexandria, Virginia 22320-0160

Telephone (703) 684-6885